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REMARKS

Claims 1-79 are in the case. Claims 1-4, 7-13, 15-19, 22-28, 30-34, 36-40, and 42-79 stand rejected under 35 U.S.C § 102(e) as being anticipated by Pedersen *et al.* (U.S. Application No. 2002/0118807). As will be shown below, Pedersen, does not anticipate identifying a context for a call as claimed in the present application. Claims 1-4, 7-13, 15-19, 22-28, 30-34, 36-40, and 42-79 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-4, 7-13, 15-19, 22-28, 30-34, 36-40, and 42-79.

Claims 5-6, 14, 20-21, 29, 35, and 41 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Pedersen in view of Mayer (U.S. Patent No. 5,774,534). As will be shown below, neither Pedersen alone nor in combination with Mayer teaches a method, system, or computer program product for identifying a context for a call as claimed in the present application. Claims 5-6, 14, 20-21, 29, 35, and 41 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 5-6, 14, 20-21, 29, 35, and 41.

Claim Rejections – 35 U.S.C. §102(e) Over Pedersen

Claims 1-4, 7-13, 15-19, 22-28, 30-34, 36-40, and 42-79 stand rejected under 35 U.S.C § 102(c) as being anticipated by Pedersen (U.S. Application No. 2002/0118807). To anticipate claims 1-4, 7-13, 15-19, 22-28, 30-34, 36-40, and 42-79 under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Pedersen must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Pedersen must enable Applicants' claims. Pedersen does not meet either requirement and therefore does not anticipate Applicants' claims.

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Pedersen Does Not Disclose Each and Every
Element of Applicants' Independent Claims 1, 43, 46, and 59

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As explained in more detail below, Pedersen does not disclose each and every element of independent claims 1, 43, 46, and 59, and Pederson therefore cannot be said to anticipate the claims of the present application within the meaning of 35 U.S.C. § 102(e).

Regarding independent claim 1 of the present application, claim 1 claims the following invention:

A method for identifying a context for a call, said method comprising:

detecting a plurality of context clues for a call; and

identifying a context for said call from said plurality of context clues, such that at least one party to said call is enabled to receive said context of said call.

The Office Action rejects independent claim 1 of the present application by generally stating:

[T]he entire patent to Pedersen is directed to a method for identifying a context for a call where the claimed detecting a plurality of context clues for a call and identifying a context for the call from a plurality of context clues are clearly provided by the interaction manager 300 of Pedersen.

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What Pedersen actually discloses as indicated at paragraphs 0022 and 0028 is a system and method for the generation of a response to a call when the callee is unavailable. The interaction manager 300 of Pedersen at paragraph 0028 actually "provides the caller 110 with a response message." The response message of Pedersen can take the form of an interactive space that includes visibility information, accessibility information, and continuity information of the callee as indicated at paragraph 0035. In Pedersen, no party to the call is enabled to receive said context of said call as claimed in the present application. The caller of Pedersen is only provided visibility information, accessibility information, and continuity information of the callee, not information about the context of a call.

The interactive manager 300 of Pedersen that provides the caller with a response message is not detecting a plurality of context clues for a call as claimed in the present application. The interactive manager 300 of Pedersen that provides the caller with a response message is also not identifying a context for said call from said plurality of context clues, such that at least one party to said call is enabled to receive said context of said call as claimed in the present application. In fact, nowhere in Pedersen do the words "detect", "detecting", "context clues", "identify", or "identifying" even appear. Because the Office Action has not disclosed each and every element of Applicants' independent claim 1, the rejection to claim 1 should be withdrawn and claim 1 allowed.

Regarding independent claim 43 of the present application, claim 43 claims the following invention:

A method for inferring a call context comprising:

receiving a context request for a call;

detecting context clues comprising at least one from among a line number, a line subscriber profile, an authenticated caller identity, an authenticated callee identity, a caller profile associated with said authenticated caller

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identity, a callee profile associated with said authenticated callee identity, a line number accessed for said call, and a geographical location served by switches processing said call; and

inferring from said context clues at least one from among who is placing said call, who is receiving said call, at least one device utilized for said call, a location of said at least one device utilized for said call, a billing plan for said call, a path of said call, and a subject matter of said call.

In rejecting claim 43, the Office Action at page 2 only mentions the following elements and limitations:

- receiving the context of the call;
- detecting a plurality of context clues for a call.

The Office Action cites the limitation of “receiving the context of the call” against claim 43, but “receiving the context of the call” appears nowhere in claim 43 of the present application. Instead, claim 43 claims “receiving a context request for a call....” The Office Action makes no mention of a “context request” as claimed in the present application. Moreover, the Office Action does not mention many of the following other elements and limitation as required in *Verdegaal Bros*:

- receiving a context request for a call;
- ... comprising at least one from among a line number, a line subscriber profile, an authenticated caller identity, an authenticated callee identity, a caller profile associated with said authenticated caller identity, a callee profile associated with said authenticated callee identity, a line number accessed for said call, and a geographical location served by switches processing said call; and

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- inferring from said context clues at least one from among who is placing said call, who is receiving said call, at least one device utilized for said call, a location of said at least one device utilized for said call, a billing plan for said call, a path of said call, and a subject matter of said call.

Though the Office Action rejects claim 43 as anticipated by Pedersen, the Office Action does not reference all of the elements and limitations of claim 43 of the present application to support the rejection under 35 U.S.C. § 102(e). Unless the Office Action can cite to a proposed reference that discloses all of the elements and limitations in Applicants' claim, the reference cannot anticipate Applicants' claim under 35 U.S.C. § 102(e). Because the Office Action does not mention all of the elements and limitations of claim 43, the Office Action cannot cite Pedersen as anticipating claim 43 of the present application under 35 U.S.C. § 102(e). Applicants respectfully request the rejection of claim 43 be withdrawn, and claim 43 be allowed.

Regarding independent claim 46 of the present application, claim 46 claims the following invention:

A method for providing a call context comprising:

detecting a call request at a central office switch;

initiating a context inference service for said call; and

receiving a context inferred for said call from at least one from among an identity of at least one party to said call, an identity of at least one device utilized for said call, a location of said at least one device, a billing plan for said call, a path of said call, and a subject matter of said call.

In rejecting claim 46, the Office Action at page 2 only mentions the following elements and limitations:

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- receive the context of the call;
- detecting a plurality of context clues for a call;
- central office switch;
- context inference service.

The Office Action cites the limitation of "receiving the context of the call" against claim 46, but "receiving the context of the call" appears nowhere in claim 46 of the present application. Instead, claim 46 claims "receiving a context inferred for said call...." The Office Action makes no mention of a "context inferred" as claimed in the present application. The Office Action cites the limitation of "detecting a plurality of context clues for a call" against claim 46, but "detecting a plurality of context clues for a call" appears nowhere in claim 46 of the present application. Instead, claim 46 claims "detecting a call request...." The Office Action makes no mention of a "call request" as claimed in the present application. Moreover, the Office Action does not mention many of the following other elements and limitation as required in *Verdegaal Bros*:

- detecting a call request at a;
- initiating a ... for said call; and
- receiving a context inferred for said call from at least one from among an identity of at least one party to said call, an identity of at least one device utilized for said call, a location of said at least one device, a billing plan for said call, a path of said call, and a subject matter of said call.

Though the Office Action rejects claim 46 as anticipated by Pedersen, the Office Action does not reference all of the elements and limitations of claim 46 of the present

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application to support the rejection under 35 U.S.C. § 102(e). Unless the Office Action can cite to a proposed reference that discloses all of the elements and limitations in Applicants' claim, the reference cannot anticipate Applicants' claim under 35 U.S.C. § 102(e). Because the Office Action does not mention all of the elements and limitations of claim 46, the Office Action cannot cite Pedersen as anticipating claim 46 of the present application under 35 U.S.C. § 102(e). Applicants respectfully request the rejection of claim 46 be withdrawn, and claim 46 be allowed.

Regarding independent claim 59 of the present application, claim 59 claims the following invention:

A method for controlling output of a call context, comprising:

receiving, in association with a call enabled by a telephony device, a tagged call context identifier at said telephony device; and

controlling output of said tagged call context identifier via at least one output interface accessible to said telephony device.

In rejecting claim 59, the Office Action at page 2 and 3 only mentions the following elements and limitations:

- receive the context of the call;
- telephony device.
- output interface

The Office Action cites the limitation of "receive the context of the call" against claim 46, but "receive the context of the call" appears nowhere in claim 46 of the present application. Instead, claim 46 claims "receiving, in association with a call enabled by a

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telephony device, a tagged call context identifier” The Office Action makes no mention of a “receiving, in association with a call enabled by a telephony device, a tagged call context identifier” as claimed in the present application. Moreover, the Office Action does not mention many of the following other elements and limitation as required in *Verdegaal Bros*:

- receiving, in association with a call enabled by a ..., a tagged call context identifier at said ...; and
- controlling output of said tagged call context identifier via at least one ... accessible to said telephony device.

Though the Office Action rejects claim 59 as anticipated by Pedersen, the Office Action does not reference all of the elements and limitations of claim 59 of the present application to support the rejection under 35 U.S.C. § 102(e). Unless the Office Action can cite to a proposed reference that discloses all of the elements and limitations in Applicants’ claim, the reference cannot anticipate Applicants’ claim under 35 U.S.C. § 102(e). Because the Office Action does not mention all of the elements and limitations of claim 59, the Office Action cannot cite Pedersen as anticipating claim 59 of the present application under 35 U.S.C. § 102(e). Applicants respectfully request the rejection of claim 59 be withdrawn, and claim 59 be allowed.

Pedersen Does Not Enable Each and Every Element
Of Independent Claims 1, 43, 46, and 59

Not only must Pedersen disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants’ claims, but also Pedersen must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant’s chemical compound. The court in *Hoeksema* stated: “We think it is sound

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law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Pedersen places Applicants' claims in the possession of a person of ordinary skill in the art, Pedersen is legally insufficient to anticipate Applicants' claims under 35 U.S.C. § 102(e).

Pedersen in fact does not place each and every element of independent claims 1, 43, 46, and 59 in the possession of a person of skill in the art. Regarding independent claim 1 of the present application, claim 1 claims the following invention:

A method for identifying a context for a call, said method comprising:

detecting a plurality of context clues for a call; and

identifying a context for said call from said plurality of context clues, such that at least one party to said call is enabled to receive said context of said call.

The Office Action rejects independent claim 1 of the present application by generally stating:

[T]he entire patent to Pedersen is directed to a method for identifying a context for a call where the claimed detecting a plurality of context clues for a call and identifying a context for the call from a plurality of context clues are clearly provided by the interaction manager 300 of Pedersen.

What Pedersen actually discloses as indicated at paragraphs 0022 and 0028 is a system and method for the generation of a response to a call when the callee is unavailable. The

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interaction manager 300 of Pedersen at paragraph 0028 actually “provides the caller 110 with a response message.” The response message of Pedersen can take the form of an interactive space that includes visibility information, accessibility information, and continuity information of the callee as indicated at paragraph 0035. In Pedersen, no party to the call is enabled to receive said context of said call as claimed in the present application. The caller of Pedersen is only provided visibility information, accessibility information, and continuity information of the callee, not information about the context of a call.

The interactive manager 300 of Pedersen that provides the caller with a response message does not place in the possession of a person of skill in the art detecting a plurality of context clues for a call as claimed in the present application. The interactive manager 300 of Pedersen that provides the caller with a response message also does not place in the possession of a person of skill in the art identifying a context for said call from said plurality of context clues, such that at least one party to said call is enabled to receive said context of said call as claimed in the present application. In fact, nowhere in Pedersen do the words “detect”, “detecting”, “context clues”, “identify”, or “identifying” even appear. Because the Office Action does not place each and every element of Applicants’ independent claim 1 in possession of a person of skill in the art, the rejection to claim 1 should be withdrawn and claim 1 allowed.

Regarding independent claim 43 of the present application, claim 43 claims the following invention:

A method for inferring a call context comprising:

receiving a context request for a call;

detecting context clues comprising at least one from among a line number, a line subscriber profile, an authenticated caller identity, an authenticated callee identity, a caller profile associated with said authenticated caller

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identity, a callee profile associated with said authenticated callee identity, a line number accessed for said call, and a geographical location served by switches processing said call; and

inferring from said context clues at least one from among who is placing said call, who is receiving said call, at least one device utilized for said call, a location of said at least one device utilized for said call, a billing plan for said call, a path of said call, and a subject matter of said call.

In rejecting claim 43, the Office Action at page 2 only mentions the following elements and limitations:

- receiving the context of the call;
- detecting a plurality of context clues for a call.

The Office Action cites the limitation of “receiving the context of the call” against claim 43, but “receiving the context of the call” appears nowhere in claim 43 of the present application. Instead, claim 43 claims “receiving a context request for a call....” The Office Action makes no mention of a “context request” as claimed in the present application. Moreover, the Office Action does not place one of skill in the art in possession of many of the following other elements and limitation as required by *Hoeksema*:

- receiving a context request for a call;
- ... comprising at least one from among a line number, a line subscriber profile, an authenticated caller identity, an authenticated callee identity, a caller profile associated with said authenticated caller identity, a callee profile associated with said authenticated callee identity, a line number accessed for said call, and a geographical location served by switches processing said call; and

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- inferring from said context clues at least one from among who is placing said call, who is receiving said call, at least one device utilized for said call, a location of said at least one device utilized for said call, a billing plan for said call, a path of said call, and a subject matter of said call.

Though the Office Action rejects claim 43 as anticipated by Pedersen, the Office Action does not reference all of the elements and limitations of claim 43 of the present application to support the rejection under 35 U.S.C. § 102(e). Unless the Office Action can cite to a proposed reference that places all of the elements and limitations in Applicants' claim in the possession of a person of skill in the art, the reference cannot anticipate Applicants' claim under 35 U.S.C. § 102(e). Because the Office Action does not mention all of the elements and limitations of claim 43, the Office Action cannot cite Pedersen as anticipating claim 43 of the present application under 35 U.S.C. § 102(e). Applicants respectfully request the rejection of claim 43 be withdrawn, and claim 43 be allowed.

Regarding independent claim 46 of the present application, claim 46 claims the following invention:

A method for providing a call context comprising:

detecting a call request at a central office switch;

initiating a context inference service for said call; and

receiving a context inferred for said call from at least one from among an identity of at least one party to said call, an identity of at least one device utilized for said call, a location of said at least one device, a billing plan for said call, a path of said call, and a subject matter of said call.

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In rejecting claim 46, the Office Action at page 2 only mentions the following elements and limitations:

- receive the context of the call;
- detecting a plurality of context clues for a call;
- central office switch;
- context inference service.

The Office Action cites the limitation of “receiving the context of the call” against claim 46, but “receiving the context of the call” appears nowhere in claim 46 of the present application. Instead, claim 46 claims “receiving a context inferred for said call....” The Office Action makes no mention of a “context inferred” as claimed in the present application. The Office Action cites the limitation of “detecting a plurality of context clues for a call” against claim 46, but “detecting a plurality of context clues for a call” appears nowhere in claim 46 of the present application. Instead, claim 46 claims “detecting a call request....” The Office Action makes no mention of a “call request” as claimed in the present application. Moreover, the Office Action does not place one of skill in the art in possession of many of the following other elements and limitation as required by *Hoeksema*:

- detecting a call request at a ...;
- initiating a ... for said call; and
- receiving a context inferred for said call from at least one from among an identity of at least one party to said call, an identity of at least one device utilized for said call, a location of said at least one device, a billing plan for said call, a path of said call, and a subject matter of said call.

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Though the Office Action rejects claim 46 as anticipated by Pedersen, the Office Action does not reference all of the elements and limitations of claim 46 of the present application to support the rejection under 35 U.S.C. § 102(e). Unless the Office Action can cite to a proposed reference that places all of the elements and limitations in Applicants' claim in the possession of a person of skill in the art, the reference cannot anticipate Applicants' claim under 35 U.S.C. § 102(e). Because the Office Action does not mention all of the elements and limitations of claim 46, the Office Action cannot cite Pedersen as anticipating claim 46 of the present application under 35 U.S.C. § 102(e). Applicants respectfully request the rejection of claim 46 be withdrawn, and claim 46 be allowed.

Regarding independent claim 59 of the present application, claim 59 claims the following invention:

A method for controlling output of a call context, comprising:

receiving, in association with a call enabled by a telephony device, a tagged call context identifier at said telephony device; and

controlling output of said tagged call context identifier via at least one output interface accessible to said telephony device.

In rejecting claim 59, the Office Action at page 2 and 3 only mentions the following elements and limitations:

- receive the context of the call;
- telephony device;
- output interface.

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The Office Action cites the limitation of "receive the context of the call" against claim 46, but "receive the context of the call" appears nowhere in claim 46 of the present application. Instead, claim 46 claims "receiving, in association with a call enabled by a telephony device, a tagged call context identifier" The Office Action makes no mention of a "receiving, in association with a call enabled by a telephony device, a tagged call context identifier" as claimed in the present application. Moreover, the Office Action does not place one of skill in the art in possession of many of the following other elements and limitation as required by *Hoeksema*:

- receiving, in association with a call enabled by a ..., a tagged call context identifier at said ...; and
- controlling output of said tagged call context identifier via at least one ... accessible to said telephony device.

Though the Office Action rejects claim 59 as anticipated by Pedersen, the Office Action does not reference all of the elements and limitations of claim 59 of the present application to support the rejection under 35 U.S.C. § 102(e). Unless the Office Action can cite to a proposed reference that places all of the elements and limitations in Applicants' claim in the possession of a person of skill in the art, the reference cannot anticipate Applicants' claim under 35 U.S.C. § 102(e). Because the Office Action does not mention all of the elements and limitations of claim 59, the Office Action cannot cite Pedersen as anticipating claim 59 of the present application under 35 U.S.C. § 102(e). Applicants respectfully request the rejection of claim 59 be withdrawn, and claim 59 be allowed.

Relations Among Claims

Independent claims 16 and 31 claim system and computer program product aspects of the method claimed in claim 1. Claims 16 and 31 therefore are patentable for the same

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reasons that claim 1 is patentable as described above. Dependent claims 2-15, 17-30 and 32-42 depend respectively from independent claims 1, 26, and 51. The dependent claims include each and every limitation of the independent claims from which they depend. The dependent claims stand because their respective independent claims stand.

Independent claims 44 and 45 claim system and computer program product aspects of the method claimed in claim 43. Claims 44 and 45 therefore are patentable for the same reasons that claim 43 is patentable as described above.

Independent claims 51 and 56 claim system and computer program product aspects of the method claimed in claim 46. Claims 51 and 56 therefore are patentable for the same reasons that claim 46 is patentable as described above. Dependent claims 47-50, 52-55 and 57-58 depend respectively from independent claims 46, 51, and 56. The dependent claims include each and every limitation of the independent claims from which they depend. The dependent claims stand because their respective independent claims stand.

Independent claims 68 and 77 claim system and computer program product aspects of the method claimed in claim 59. Claims 68 and 77 therefore are patentable for the same reasons that claim 59 is patentable as described above. Dependent claims 60-67, 69-76 and 78-79 depend respectively from independent claims 59, 68, and 77. The dependent claims include each and every limitation of the independent claims from which they depend. The dependent claims stand because their respective independent claims stand. Pedersen therefore does not anticipate Applicants' claims 1-79 within the meaning of 35 U.S.C § 102(e).

Claim Rejections - 35 U.S.C. § 103

Claims 5-6, 14, 20-21, 29, 35, and 41 stand rejected under 35 U.S.C § 103(a) as unpatentable over Pedersen in view of Mayer. Applicants respectfully traverse each rejection. To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* § 2142. The first element of a prima facie

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case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

The Combination Of Pedersen And Mayer Does Not
Teach Or Suggest All Of Applicants' Claim Limitations

To establish a prima facie case of obviousness, the proposed combination of Pedersen and Mayer must disclose or suggest all of Applicants' claim limitations of claims 5-6, 14, 20-21, 29, 35, and 41. As shown above, Pedersen fails to disclose each and every element of independent claims 1, 16, 31, 43, 44, 45, 46, 51, 56, 59, 68, and 77. Pedersen, alone or in combination, with Mayer therefore fails to disclose each and every element of dependent claims 5-6, 14, 20-21, 29, 35, and 41 because the Office Action only cites Pedersen as teaching the claim limitations found in independent claims 1, 16, 31, 43, 44, 45, 46, 51, 56, 59, 68, and 77. Pedersen, alone or in combination, with Mayer therefore cannot disclose each and every element of the referenced dependent claims. The Office Action therefore fails to make a prima facie case for obviousness under 35 U.S.C. § 103. The rejections of claims 5-6, 14, 20-21, 29, 35, and 41 under 35 U.S.C. § 103 are improper and should be withdrawn.

No Suggestion or Motivation to Combine Pedersen and Mayer

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Pedersen and Mayer. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to combine Pedersen and Mayer

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must come from the teaching of either Pedersen or Mayer themselves, and the Examiner must explicitly point to the teaching within Pedersen or Mayer suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaack*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action makes no mention whatsoever of any place in any of the references that suggests or provides any motivation for the proposed modification of Pedersen, alone or in combination, with Mayer. Instead, the Office Action at page 5 merely asserts that the combination of Pedersen with Mayer would be obvious to one of ordinary skill in the art. Such a bare assertion incorporates "hindsight" from the present application that is impermissible under *In re Surko*.

Further, no suggestion or motivation to combine Pedersen and Mayer can come from the teaching of either Pedersen or Mayer because the references operate under different premises. Pedersen at paragraph 0022 discloses a system and method for the generation of an automatic response to a call which has reached a terminating telephone number when the intended callee is unavailable. In Pedersen, a callee is unavailable because the callee does not answer the call. Instead, the caller is provided an interaction space generated by the interaction manager. Mayer at column 1, lines 10-17, and column 4, lines 46-51 and lines 61-65, discloses a system and method for routing to an appropriate terminating telephone number a call to a nationally advertised number in order that the call can be handled by a transaction processor or call center. In Mayer, no unavailable caller exists. Pedersen and Mayer operate under very different premises. Neither Pedersen nor Mayer contains a suggestion or motivation to combine Pedersen with Mayer. The Office Action therefore fails to make a prima facie case for obviousness under 35 U.S.C. § 103. The rejections of claims 5-6, 14, 20-21, 29, 35, and 41 under 35 U.S.C. § 103 are improper and should be withdrawn.

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No Reasonable Expectation of Success in the
Proposed Combination of Pedersen and Mayer

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Pedersen and Mayer. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The teachings of Pedersen and Mayer are not sufficient to render the claims prima facie obvious if the proposed combination of Pedersen and Mayer would change the principle of operation of either Pedersen or Mayer. *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349 (CCPA 1959).

The Office Action makes no mention whatsoever of any place in any of the references that suggests or provides any reasonable expectation of success in the proposed modification of Pedersen, alone or in combination, with Mayer. In fact, the combination of Pedersen and Mayer changes the principle operation of the references. Pedersen's principle of operating is the generation of an automatic response to a call which has reached a terminating telephone number when the intended callee is unavailable, while Mayer operates to route to a transaction processor or call center at a terminating telephone number a call placed to a nationally advertised number. The combination of Pedersen's automatic response to a call which has arrived at a terminating telephone number with Mayer's routing of a call to a terminating telephone number for handling by a transaction processor or call center would change the principles of operation of both Pedersen and Mayer. Pedersen would have to route a call to a transaction processor or call center for handling instead of providing an interaction space to the caller when the callee is unavailable. Mayer would have to receive and respond to a call when the callee is unavailable instead of routing the call to a transaction processor or call center at a terminating telephone number. The proposed combination of Pedersen and Mayer cannot therefore be effected without changing completely the principles of operation of both references and, in fact, will not function at all. The Office Action therefore fails to make a prima facie case for obviousness under 35 U.S.C. § 103. The rejections of claims 5-6, 14, 20-21, 29, 35, and 41 under 35 U.S.C. § 103 are improper and should be withdrawn.

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Neither Pedersen alone nor in combination with Mayer discloses each and every element of claims 5-6, 14, 20-21, 29, 35, and 41. There is no suggestion to modify Pedersen, alone or in combination with Mayer, and there is no reasonable expectation of success in the proposed combination of Pedersen and Mayer. The Office Action therefore does not establish a *prima facie* case of obviousness under 35 U.S.C. § 103. Applicants respectfully traverse the rejection to each of claims 5-6, 14, 20-21, 29, 35, and 41 and request that the claims be allowed.

Conclusion

Claims 1-4, 7-13, 15-19, 22-28, 30-34, 36-40, and 42-79 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Pedersen *et al.* (U.S. Application No. 2002/0118807). Pedersen, does not anticipate identifying a context for a call as claimed in the present application. Claims 1-4, 7-13, 15-19, 22-28, 30-34, 36-40, and 42-79 are therefore patentable and should be allowed. Claims 5-6, 14, 20-21, 29, 35, and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pedersen in view of Mayer (U.S. Patent No. 5,774,534). As will be shown below, neither Pedersen alone nor in combination with Mayer teaches a method, system, or computer program product for identifying a context for a call as claimed in the present application. Claims 5-6, 14, 20-21, 29, 35, and 41 are therefore patentable and should be allowed. Applicants respectfully traverse the rejection to each of claims 1-79 and respectfully request the allowance of claims 1-79.

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The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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